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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,222	05/23/2005	Georg Gros	DNAG-292 (10112294)	2140
24972	7590	08/08/2008		
FULBRIGHT & JAWORSKI, LLP			EXAMINER	
666 FIFTH AVE			CAMERON, ERMA C	
NEW YORK, NY 10103-3198				
			ART UNIT	PAPER NUMBER
			1792	
			MAIL DATE	DELIVERY MODE
			08/08/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/511,222

**Applicant(s)**

GROS, GEORG

**Examiner**

/Erma Cameron/

**Art Unit**

1792

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 66-108 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 66.69-71.73.76.77.79-81.100.101.104.106 and 107 is/are allowed.
- 6) ☒ Claim(s) 67.68.72.74.75.78.82.89-92.95-99 and 108 is/are rejected.
- 7) ☐ Claim(s) 83-88.93.94.102.103 and 105 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/27/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. The rejection of Claims 26-65 under 35 U.S.C. 112, second paragraph, is withdrawn because these claims are canceled .
3. Claims 67, 68, 72, 74, 75, 78, 82, 89-92, 95-99 and 108 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - a) Claim 67, line 6: it appears that "the mixture comprises" has been left out of this line.
  - b) Claim 68 and 82: it is not clear what is meant by "inorganic particles other than (or alternatively "without")the electrically conductive particles", as independent claim 66 does not refer to any particles except electrically conductive ones.

- c) Claim 68 and 82: the meaning of these claims is not clear.
- d) Claim 72: it appears there should be a comma after “alloy”.
- e) Claim 74: “ground with before” does not make sense.
- f) Claim 75 and 89: does not make sense.
- g) Claim 90: lacks a period.
- h) Claim 91: lacks a verb.
- i) Claims 78 and 92: preferably and particularly preferably makes the limitations of the claim uncertain.
- j) Claim 95: how can a substrate be a coating?
- k) Claims 96 and 97 and 99: it appears that it should be “particles project”.
- l) Claims 97-99: “can be set” is vague in that it is not clear if it is set or not.

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m) Claim 108: "substantial " is not defined and vague.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The rejection of Claims 58-65 under 35 U.S.C. 112, first paragraph ("resin"), is withdrawn because these claims are canceled.

6. The rejection of Claims 58-65 under 35 U.S.C. 112, first paragraph ("a composition that comprises inorganic particles that either have the transfer value d99 of claim 26 or the particle size distribution of claim 27") is withdrawn because these claims are canceled.

7. The rejection of Claims 58-65 under 35 U.S.C. 112, first paragraph ("a composition that would result in some of the inorganic particles projecting from an applied dried coating"), is withdrawn because these claims are canceled.

8. The rejection of Claims 26-65 under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling is withdrawn because these claims are canceled.

9. The rejection of Claims 58-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is withdrawn because these claims are canceled.

10. Claims 97, 98 and 99 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The following was not in the specification as filed, and is therefore not enabled:

Claims 97, 98, 99: can be set through two substrates

Claim 99: thickness of at least 2 um

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The rejection of Claims 58-65 under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (5001173) is withdrawn because of the amendment filed 5/27/2008.

13. The rejection of Claims 58-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moyle et al (5260120) is withdrawn because of the amendment filed 5/27/2008.

***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Erma Cameron/ whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erma Cameron/

Primary Examiner

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July 29, 2008